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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LILLING, HERBERT J

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,502

Applicant(s)

BHADRA ET AL.

Examiner

HERBERT J LILLING

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-17,20-38 and 40-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-17,20-38 and 40-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Receipt is acknowledged of the amendment filed January 21, 2003.

2. Claims 13-17, 20-38 and 40-52 are now pending in this application.

Claims 1-12, 18, 19 and 39 have been cancelled.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention, see *In re Wilder*, 736 F.2d 1516, 1521, 222 USPQ 369, 372- 73 (Fed. Cir. 1984) Accordingly, naming a type of material generally known to exist, **in the absence of knowledge as to what that material consists of, that is the "extract" and the expression "pharmaceutical acceptable additive" are not a description of that material.**

Thus, Claims 13-52 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The expression "extracts of" and "pharmaceutical acceptable additive" are completely not acceptable since the expression "extracts of" lacks any defined "metes and bounds" in the claimed inventions and the term "additive" includes active ingredients which is also not acceptable.

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The enablement as well as the written description of the instant specification lack support for the claimed ingredients. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification lacks adequate written description for the claimed inventions in view of the following points in accordance with the written description requirements of 35 U.S.C. 112:

The description must clearly allow persons of ordinary skill in the art to recognize what is claimed. Thus, an applicant must comply with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966. Thus both the expressions as "extracts of plants" and "pharmaceutical acceptable additives" fail to meet the requirements.

An adequate written description of the ingredients requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expressions:

i.> Claim 14 "or extracts of plants selected...." .

It is acknowledged that applicant has additional claims that contained the above expression which were rejected for the "extract" per se in the above paragraph.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13, 14, 17, 20, 21, 22, 33, 40-45 and 51 are rejected under 35 U.S.C. 102(b) as anticipated by :

A. [claims 13, 14, 17, 20-22, 33 and 51]

Derwent Abstract 1995-228634 of Patent JP07138180;

B. [claims 13, 14, 17, 20-22, 33 and 51]

Ramsewak et al 1999:38735

or

C. [Claims 40-45 and 51]

Ahmad Kartini Abstract "Chemical constituents of *Murraya Koenigii* (Rutaceae) and their biological activities" May 1999 Univ . Putra Malaysia Thesis –Goggle Web Site: [Publication Type: Dissertation, Thesis Name of Candidate: Kartini The study on *Murraya koenigii* (curry leaf) involves extraction, separations by using various ... CHC1(3) and MeOH crude extracts of leaves, the methanol extract of ...
[uru.upm.edu.my/IRResearch.nsf/ff29090c9567ef71c82565f700081f04/
193ddd0ef0d81283482569a2000fedf2?OpenDocument - 8k]

A. Derwent abstract teaches the preparation of extracts of *Murraya koenigii* which process includes the extraction and lyophization (freeze drying) and it is presumed to be within the scope of the recited process of ambient temperature which processes includes in Example 6 of the patent, *Murraya koenigii*.

The extract of 51 is considered to be within the scope of the claimed product by process absent a showing to the contrary.

B. Ramsewak et al teaches extracts of *Murraya koenigii* which have antioxidant activity that is within the scope of product composition claim 22. The extract by the reference is the same as that is disclosed on page 3, line 13, acetone which is presumed to yield the same products as claimed absent a showing to the contrary.

The extract of 51 is considered to be within the scope of the claimed product by process absent a showing to the contrary.

C. Kartini teaches the following:

The study on *Murraya koenigii* (curry leaf) involves extraction, separations by using various chromatographic methods and structural determination by spectroscopic techniques such as IR, NMR including 2D-NMR and MS. The pet.ether, CHCl₃ and MeOH crude extracts of leaves, the methanol extract of stem bark, mahanimbine (31) and girinimbine (32) failed to show significant antimicrobial activity, while the pet.ether and the chloroform crude extracts of the stem bark exhibited weak antibacterial activity against *Bacillus cereus*.

The reference clearly anticipates the methods of extracting the leaves with a solvent within the scope of the claimed method inventions [claims 40-45, 48-50 and 51]

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 46-47 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kartini.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

It would have been prima facie obvious to one of ordinary skilled in the art to perform the extraction for the time period as well as to remove the solvent under reduced pressure at room temperature absent a showing of unexpected results.

7. **No claim is allowed.**

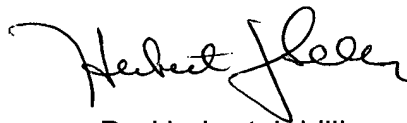
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Lilling whose telephone number is (703) 308-2034** and **Fax Number** is for applications **Before Final** (703) 872-9306 and **After Final** for applications is 703-872-9307 or SPE Michael Wityshyn whose telephone number is (703) 308-4743. Examiner can be reached Monday-Thursday from about 5:30 A.M. to about 3:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

H.J.Lilling: HJL
(703) 308-2034
Art Unit 1651
February 12, 2003

A handwritten signature in black ink, appearing to read "Herbert J. Lilling". The signature is fluid and cursive, with a large initial "H" and "J".

Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1651